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AF/ 3627 #

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

*In re* Application of

Daniel R. POTTER ET AL.

Serial Number 10/099,685

Filed: March 14, 2002

For: CUSTOM FIT SALE OF FOOTWEAR

Group Art Unit: 3627

Examiner: Andrew J. Rudy

Attorney Reference: 005127.00033

**APPEAL BRIEF**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Alexandria, VA 22313

Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from a decision of the Primary Examiner finally rejecting claims 10-14 in the above-captioned patent application.

***(1) Real Party In Interest***

The real party in interest is Nike Corporation, a U.S. corporation having a place of business in Beaverton, Oregon.

***(2) Related Appeals and Interferences***

Appellants and their legal representatives are unaware of any appeals or interferences related to the subject appeal.

***(3) Status of Claims***

Claims 1-14 (reproduced for reference in the Claims Appendix) are pending in the application, with claims 1 and 10 being independent claims. Claims 1-9 were not elected in response to a restriction requirement, however, and thus were withdrawn from consideration. In a

final Office Action dated September 8, 2004, the Primary Examiner rejected each of elected claims 10-14.

***(4) Status of Amendments***

No amendments have been made to the claims following the final Office Action of September 8, 2004. In an effort to further prosecution of this application, Appellants submitted a Request For Consideration on March 10, 2005, but this Request did not present claim amendments.

***(5) Summary Of Claimed Subject Matter***

The claimed subject matter relates to a shoe distribution center for providing shoes to a plurality of customer. (See, e.g., the specification, paragraph 12, lines 1-2.) The shoe distribution center includes an order receiving unit. The order receiving unit receives footwear orders from customers through remote communication channels. (*Id.*, paragraph 18, lines 1-4.) The order will include various information identifying the desired footwear, including the particular model of footwear desired and the last by which the customer wishes to have the ordered shoes manufactured. (*Id.*, paragraph 30, lines 2-8.)

The shoe distribution center also includes a footwear inventory that contains one or more models of footwear in a variety of sizes. (*Id.*, paragraph 18, lines 4-6). Each pair of footwear incorporates a moldable fit-component that allows each shoe to be remolded to lengths and widths differing from its original length and width. (*Id.*, paragraph 21, lines 1-6).

Still further, the shoe distribution center includes a footwear manufacturing unit for remolding lengths and widths of pieces of footwear in the footwear inventory. (*Id.*, paragraph 18, lines 4-9.) The footwear manufacturing unit remolds the lengths and widths of footwear ordered by a customer using the last identified in the customer's order. (*Id.*, paragraph 33, lines 1-5).

***(6) Grounds Of Rejection To Be Reviewed On Appeal***

The following grounds of rejection are presented to the Board of Patent Appeals and Interferences for review in this appeal:

- (a) Claims 10 and 11 have been rejected under 35 U.S.C. §103 over U.S. Patent No. 5,515,268 to Yoda in view of U.S. Patent No. 5,714,098 to Potter, and in further view of U.S. Patent No. 5,783,810 to Kelly, Jr.
- (b) Claims 12-14 have been rejected under 35 U.S.C. §103 over the combination of the Yoda, Potter, and Kelly, Jr. patents, and in further view of U.S. Patent No. 5,339,252 to White et al.

#### **(8) Arguments**

The Primary Examiner rejected claims 10 and 11 under 35 U.S.C. §103 over U.S. Patent No. 5,515,268 to Yoda in view of U.S. Patent No. 5,714,098 to Potter, and in further view of U.S. Patent No. 5,783,810 to Kelly, Jr. Appellants respectfully traverse this rejection, and courteously ask for its reversal.

Appellants courteously urge that the Primary Examiner has not set forth a *prima facie* showing of obviousness necessary to sustain this rejection.

“A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 9 F.3d 1531, 20 U.S.P.Q.2d, 1955, 1956 (Fed. Cir. 1993).

Appellants submit that the Primary Examiner cannot have established the required *prima facie* showing of obviousness *because none of the cited prior art reference teach or suggest subject matter recited in the claims*.

Claims 10-14 recite “an order receiving unit that receives orders from customers for footwear to custom fit the customer, each order identifying at least one last.” Thus, this claim recites an order receiving unit that allows customers to order footwear based upon a last shape rather than a conventional size/width combination.

These claims additionally recite “a footwear manufacturing unit for remolding lengths and widths of pieces of footwear in the footwear inventory using lasts identified in orders received by the order receiving unit.” Accordingly, claims 10-14 recite manufacturing unit that manufactures footwear for a customer using the last specified in the customer’s order.

Applicants respectfully point out that these features of the invention, while allow a customer to ordering footwear according to a desired a last, is not taught or suggested by any

combination of the Yoda, Potter, and Kelly, Jr. patents. Thus, no combination of the Yoda, Potter et al. and Kelly, Jr. patents could suggest the subject matter recited in claims 10-14.

First, the Yoda patent discloses a method and system for ordering various products, such as footwear. With the method taught in the Yoda patent, a local sensor device detects a customer's body size information, and outputs this size information as body image of the customer rendered on a display. An image of a desired product is then superimposed over the body image. Based upon this superimposition, the customer decides whether the size of the desired product is appropriate. (See, e.g., Yoda, column 1, line 57 to column 2, line 13). Nothing in the Yoda patent would suggest custom-ordering footwear by identifying a specific last, as recited in claims 10-14, and the Primary Examiner has not argued otherwise.

Similarly, the Kelly, Jr. patent makes no mention of using last information to custom-order footwear. Instead, the Kelly, Jr. patent generally discloses an apparatus and method for tracking inventory of multiple goods in multiple shipping cartons.

The Potter et al. patent does describe a technique for custom-manufacturing footwear by remolding the footwear using a specific last. Notably, however, the Potter patent does not teach or suggest having the customer specify the last when requesting a pair of footwear. Potter instead describes having the customer try on sample footwear at a retail location. If the desired size is not in stock, then footwear with a similar size is remolded using a last. Thus, this patent likewise does not teach or suggest custom-ordering footwear by identifying a specific last and then having that footwear manufactured using the specified last.

As none of the Yoda, Potter, and Kelly, Jr. patents teach or suggest recited features of the invention, Appellants again urge that no combination of these documents could support a *prima facie* showing of obviousness required to sustain the outstanding rejection of claims 10 and 11 under 35 U.S.C. §103. Appellants therefore ask that this rejection be reversed.

The Primary Examiner also rejected claims 12-14 under 35 U.S.C. §103 over the combination of the Yoda, Potter, and Kelly, Jr. patents, and in further view of U.S. Patent No. 5,339,252 to White et al. Appellants respectfully traverse this rejection, and courteously ask for its reversal as well. Again, Appellants submit that the Primary Examiner has not set forth a *prima facie* showing of obviousness necessary to sustain this rejection.

As discussed in detail above, no combination of the Yoda, Potter, and Kelly, Jr. patents would teach or suggest the features of the invention recited in claims 12-14. Appellants urge that the White et al. patent does not remedy the omissions of the Yoda, Potter, and Kelly, Jr. patents.

The White et al. patent describes an integrated system for manufacturing lasts and footwear. According to the system described in the White et al. patent, however, a customer has his or her foot scanned to determine size information. This information is then used to create a last. Appellants therefore submit that the White et al. patent would actually teach away from custom-ordering footwear by specifying a last, as recited in claims 12-14.

Accordingly, Appellants respectfully submit that no combination of the Yoda, Potter, Kelly, Jr. and White et al. patents would teach or suggest recited features of the invention. It is therefore again urged that no combination of these documents thus could support a *prima facie* showing of obviousness required to sustain the outstanding rejection of claims 12-14 under 35 U.S.C. §103. Appellants therefore ask that this rejection be reversed

#### ***(9) Conclusion***

The rejections submitted in the final Office Action of September 8, 2004 should be reversed for at least the reasons recited above. Allowance of claims 10-14 is, therefore, respectfully requested.

A Petition For A Two Month Extension Of Time is being concurrently with this Appeal Brief. The Commissioner is authorized to charge the associated fees of:

(a) \$500.00 for the filing of this Appeal Brief; and

(b) \$450.00 for the Petition For Extension Of Time

to deposit account number 19-0733. It is believed that no additional fees are due in connection with this Appeal Brief. Should additional fees be deemed necessary, however, such fees are

hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fees.

Respectfully submitted,

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## ***CLAIMS APPENDIX***

1. (Withdrawn) A method of providing footwear, comprising:  
receiving a request from a customer for footwear;  
determining at least one last associated with the customer for manufacturing the footwear; and  
providing the customer with the footwear after the footwear has been manufactured with the at least one last.
2. (Withdrawn) The method of providing footwear recited in claim 1, wherein the request identifies the last associated with the customer.
3. (Withdrawn) The method of providing footwear recited in claim 1, wherein the request provides an identity for the customer, and the identity provided in the request is used to determine the last associated with the customer.
4. (Withdrawn) The method for providing footwear recited in claim 1, further including using the last to reform a shape of an interior of the footwear before providing the footwear to the customer.
5. (Withdrawn) The method for providing footwear recited in claim 4, wherein the last is used to reform a length of the interior of the footwear.
6. (Withdrawn) The method for providing footwear recited in claim 4, wherein the last is used to reform a width of the interior of the footwear.
7. (Withdrawn) The method for providing footwear recited in claim 6, wherein the last is used to also reform a length of the interior of the footwear.
8. (Withdrawn) The method for providing footwear recited in claim 1, further including using the last to construct the footwear from material pieces.
9. (Withdrawn) The method for providing footwear recited in claim 1, further including determining a first last associated with the customer for manufacturing a left shoe, and determining a second last associated with the customer for manufacturing a right shoe; and providing the customer with the footwear after the left shoe of the footwear has been manufactured with the first last and the right shoe of the footwear has been manufactured with the second last.
10. (Amended) A shoe distribution center, comprising:

an order receiving unit that receives orders from customers for footwear to custom fit the customer, each order identifying at least one last;

a footwear inventory containing a plurality of pieces of footwear in a variety of sizes, such that an interior of each piece of footwear incorporates a moldable fit-component that allows that piece of footwear to be remolded to lengths and widths differing from that piece of footwear's original lengths and widths; and

a footwear manufacturing unit for remolding lengths and widths of pieces of footwear in the footwear inventory using lasts identified in orders received by the order receiving unit.

11. (Original) The shoe distribution center recited in claim 10, wherein the footwear manufacturing unit includes:

a last inventory containing a plurality of lasts that can be used to remold lengths or widths of at least some of the pieces footwear in the footwear inventory; and

a heating unit for heating the lasts to remold lengths or widths of at least some of the pieces footwear in the footwear inventory.

12. (Original) The shoe distribution center recited in claim 10, wherein the order-receiving unit includes a server computer for receiving orders for custom fitting footwear over an electronic communication network.

13. (Original) The shoe distribution center recited in claim 10, wherein the order-receiving unit includes an automated voice menu system for receiving orders for custom fitting footwear over a telephone service.

14. (Original) The shoe distribution center recited in claim 10, further comprising:

a customer/last database containing one or more customer records, such that each record includes a customer field identifying a customer and at least one last field identifying a last associated with the customer.